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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,267	11/14/2001	Burkhard Standke	209350US0	6970
22850	7590	12/09/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ROBERTSON, JEFFREY	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

Application No.

09/987,267

Applicant(s)

STANDKE ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 4 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 9/9/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in the specification on pages 3 and 4, applicant has added "t-butyl" to the definitions of R and R". It is noted that the addition of these groups was not underlined even though this group was not present previously in the specification. Applicant has not pointed to any support for this addition. Regarding newly presented formula (I), the examiner agrees that this formula generally would fairly represent the cyclic and net-like structures, the support coming from applicant's previous disclosure of the starting materials of organotrichlorosilane and tetrachlorosilane. However, in the amendment to pages 3 and 4, in the newly presented formula (I), the presence of OH groups on the siloxane is not supported by the disclosure. Also, since R' is defined as methyl or ethyl, applicant has no support for changing these variables to include hydrogen.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

2. Claims 4 and 20 are objected to because of the following informalities: for claim 4, the greater than or equal sign in line 2 runs into the 0.6. For claim 20 in line 11, there

should be a space between organoalkoxysiloxane and product. Appropriate correction is required.

***Comments on Claims***

3. For claims 19 and 20, although applicant has not set forth the general formulas  $\text{RSiCl}_3$  and  $\text{R}''\text{SiCl}_3$  previously in the specification or claims, given the fact that applicant has set forth support for the R and R'' groups listed, except as set forth below, and that there are specific formulas set forth of organotrichlorosilanes, the examiner finds adequate support for these formulas. It is also noted that in claims 19 and 20, the antecedent basis for the term organotrichlorosilanes are the formulas  $\text{RSiCl}_3$  and  $\text{R}''\text{SiCl}_3$  themselves previously set forth in the claims.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For claims 1, 19, and 20, there is no support for the addition of "t-butyl" to the definitions of R and R''. It is noted that the addition of this group to claim 1 was not underlined even though this group was not present

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previously in the claim. Applicant has not pointed to any support for this addition. For claim 1, in the newly presented formula (I), the presence of OH groups on the siloxane is not supported by the disclosure. Also, since R' is defined as methyl or ethyl, applicant has no support for changing these variables to include hydrogen. See paragraph 1 above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 19 and 20, there is a lack of antecedent basis in the "(i)" component for the molecular ratios. Neither claim 19 nor 20 sets forth an (i) component.

### ***Allowable Subject Matter***

8. Claims 1-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, and the claim objections set forth in this Office action. See the comments set forth below.

### ***Response to Arguments***

9. Regarding the Fischer et al. reference, in reviewing applicant's arguments and the reference itself, the examiner has withdrawn the rejection even though the examiner

disagrees with some of applicant's assertions. First, the examiner disagrees with applicant's statement that Fischer teaches that the reaction is performed in the head of reaction distillation column. The drawing of Fischer clearly shows that the reactor is separated from the distillation column. Also, in column 2, lines 36-44, Fischer discloses that conventional reaction vessels maybe used. Nowhere in the reference does Fischer mention the use of the head of a reaction distillation column in carrying out the reaction.

Second the examiner disagrees with applicant's interpretation of claim 1. Applicant argues that claim 1 requires that the continuous reaction take place in a first reaction distillation column. However, this is not the case. There is no mention of a first reaction distillation column in claim 1, only a first process stage. In addition, the claim does not mention a second stage reactor. Claim 1 requires that the second stage take place in a reaction distillation column.

Last, the examiner disagrees with applicant's assertion that the variables of molar ratio, temperature, and time are not result effective variables. As stated by applicant, the parameters have been developed and understood in terms of a staged continuous process. As stated in the previous office action, there is nothing on the record to suggest that the ranges set forth by applicant amount to anything over than an optimization of those variables.

Upon reviewing the Fischer reference, the examiner agrees that Fischer does not teach or suggest a continuous process that takes place in stages as set forth in the present claims. Although Fischer does teach a continuous process where chlorosilane and alcohol are continuously metered and situations where the rest of the reaction can

take place in the column, column 2, line 60 through column 3, line 38, Fischer does not teach or suggest that the complete process takes place in a continuous manner. In situations where the rest of the reaction takes place in the column, Fischer describes that this occurs where raw product is put back into the reactor prior to transfer into the column where Fischer does not set forth that this process is continuous. This is contrary to applicant's claimed process, which requires that the crude products are proportionally transferred from the first stage into a subsequent second stage.

The previous objection to the specification and rejection under 35 U.S.C. 112 2<sup>nd</sup> paragraph over claims 10-18 is withdrawn in light of applicant's amendments made to both the specification and claims.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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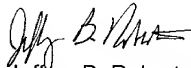
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929, and after 12/9/03 (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeffrey B. Robertson  
Examiner  
Art Unit 1712

JBR



DANIEL S. METZMAIER  
PRIMARY EXAMINER

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